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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,518	08/24/2001	Mark J. Jaroszeski	93004	2429

7590 03/13/2003
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EXAMINER

ANGELL, JON E

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 03/13/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/939,518

Applicant(s)

JAROSZESKI ET AL.

Examiner

J. Eric Angell

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2,4-8,10-12,14-18 and 20.


Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE: The amended and new claims would require further consideration under 112, first paragraph (new matter and enablement) as well as require further search and consideration. For instance the new claim 21 would require the limitation of a continuous low-level electric field for a duration of 200ms-20min. This would require a further search to identify art that encompasses this limitation. Furthermore, it is pointed out that claim 22 is outside of the scope of claim 21 because it indicates that the duration is in the range of 100ms-100sec. Therefore, claim 22 does not further limit claim 21. The amendment would require further search and consideration for the reasons indicated above. Therefore, the amendment is not entered.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the 102(a) rejection of claims 1, 4,5, 14-20 as being anticipated by Bettan, and the rejection of claims as being anticipated by Mir.

Continuation of 5. does NOT place the application in condition for allowance because: First with regard to the Katz declaration, Applicants indicate that in view of the proposed amendments the Declaration is not warranted. In response, the amendment has not been entered; therefore, the rejection can not be withdrawn, as there are no arguments or declaration to overcome the rejection. With regard to the rejection of claims in view of the Bettan reference, Applicants' arguments indicating that Bettan does not teach the invention with the claimed limitations are persuasive and the rejection is withdrawn. Similarly the rejection of claims as being anticipated by Mir is also withdrawn because Mir does not meet the limitation of the claims. With respect to the rejection of claims as being anticipated by Hofmann, Applicants' arguments have been fully considered, but are not found persuasive. Applicants argue that Hofmann does not teach or suggest the use of a single low-level pulse applied for a duration of 100ms-20min to effect entry of a molecule into the cell. Applicants also indicate that Hofmann teaches using a series of pulses. First, it is respectfully pointed out that the pending claims are not limited to a method of using a single pulse because the claims clearly indicate a method for facilitation entry of a molecule into a tissue comprising a cell *comprising* the steps of: applying a *substantially continuous* low-level electric field to the target tissue... (emphasis added for clarity). It is noted that the claims as written are not limited to a single low-level pulse, therefore the rejection of claims as being anticipated by Hofmann are appropriate.


DAVE T. NGUYEN
PRIMARY EXAMINER